



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

John E. Nemire

Serial No.: 09/079,814

Filed: 05/16/98

For: Fishing Lure System

Group Art Unit: 3643

Examiner: Kurt Rowan

Att'y Docket No.: P98293

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

Election / Restriction

In response to a restriction requirement set forth in telephone conference on Jan. 8, 2001 with applicant, a provisional election with traverse was made by applicant to prosecute Claims 1-20. Applicant hereby affirms such provisional election with traverse to prosecute Claims 1-20.

Reconsideration is respectfully requested.

The Examiner required restriction among Invention I - Claims 1-20 drawn, put briefly, to a fishing lure; Invention II - Claims 21-22, drawn, put briefly, to a rattle for use with a fishing lure; and Invention III - Claims 23-24, drawn, put briefly, to a propeller for use with a fishing lure.

Restriction among these three areas was required because the Examiner thought that:

I. Invention I and II are related as combination and subcombination;

II. Invention I and III are related as combination and subcombination; and

III. Invention II and III are related as subcombination and subcombination.

In the instant case, the Examiner thought that Inventions II (Propeller) and III (Noise Maker/Rattle) each had separate utility independent of the lure of Invention I, and independent of each other.

The Commissioner may require restriction if two or more

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independent and distinct inventions are claimed in one application (35 U.S.C. § 121). In the present case, although the claimed subject matter may appear to be classified in different classes, the requirement for restriction is not proper. In accordance with the requirement found in the M.P.E.P. § 803, if search and examination of the entire application can be made without undue burden to the Examiner, the Examiner must examine all the claims on the merits regardless of whether the application contains claims to independent or distinct inventions. In the present case, the three Inventions I, II, and III, are all in the same class 43, and furthermore in the same main subclass 42.

Furthermore, as a further example, inasmuch as the provisionally elected Invention I was classed in Class 43, subclass 42.16, and yet, the Examiner cited art from Class 43, subclass 42.31, which was the classification given for Invention II, the Examiner is already searching multiple subclasses containing more than just the Elected Invention I.

Therefore applicant respectfully submits that the Examiner's restriction should be moot as the Examiner has already searched multiple subclasses containing these multiple inventions and thus a serious burden would not be placed upon the Examiner if all Claims 1-24 were searched and examined. In view of these matters, it is respectfully requested that the restriction requirement be withdrawn and that each of the Claims presently pending in this application be examined.

Amendment

The Examiner's comments and the cited references of the Office Action mailed 01/16/01 have been carefully considered, and, responsive thereto, applicant amends and states as follows:

Please amend the claims in this application as follows:

Rewrite Claim 1 in amended form as the following Claim 1 (Amended):

1. (Amended) A fishing lure, for use with a fishing rod having a fishing line, for catching fish, comprising in combination:

a. an elongated body portion having longitudinal central axis, a concave inner surface, a convex outer surface, a rounded leading edge, and a rounded trailing edge, said body portion further having a hole therethrough;

b. a snaring means, attached to said body portion, for ensnaring a fish;

c. a rattle means, attached to said body portion, for emitting a vibration;

d. a rattle holding means, attached to said concave inner surface of said body portion, for holding said rattle means;

e. an attachment means for attaching said fishing line to said body portion, wherein said attachment means is substantially rigidly held proximate to said hole.

Rewrite Claim 16 in amended form as the following Claim 16

(Amended):